

## REMARKS

### **1. Confirmation of Restriction and Election.**

Applicant confirms the election of the claims of Group I, namely Claims 1-19, for examination in this patent application, and restricts the patent application to these claims. Claim 20 has been canceled without prejudice as drawn to a non-elected species.

### **2. Brief Description of the Invention to Assist the Examiner.**

As disclosed and claimed, the invention is a clinical tool to assist employers, employees, and medical personnel in determining if a certain already-specified job or activity can be undertaken by a person. The description of the invention the examiner provided in Paragraph 7 of the Office Action is somewhat off the point. Each job has associated with it one or more tasks. Each task may have certain minimum and maximum (yes, maximum) strength or motion requirements. The invention is not to create a job for a person, but is to determine whether a person can carry out a particular job.

An industrial plant, for example, has many different jobs. Each of these jobs comprises one or more tasks. To determine whether a person can carry out the various tasks required by a job, the parameters of the tasks must be quantified and compared to the capabilities of the potential jobholder. One application of the invention is for determining whether an injured worker can be put back to work at his or her prior job or, if not, to determine if the plant has an alternative job suitable for the worker. For example, the doctor for an injured worker may decide that the injured worker cannot lift more than 10 pounds and cannot lift his or her arm above the shoulder. Thus, the worker can be paired with a job that has a maximum lifting weight of 10 pounds and a maximum arm rotation of 90 degrees (horizontal).

In operation, once the job requirements and the physical demands analysis are created into a database, the database can be searched to determine if a particular person is capable of performing a particular job, and to search for a job that a particular person is capable of performing. The invention is not to create jobs or tasks, or to tailor a job to fit a worker. The invention starts with the premise that the particular jobs are already created and already have certain tasks associated with them. From there, the invention is a tool for determining whether a worker can

perform a specific job, or whether the physical limitations, such as the maximum strength or motion parameters associated with the job, fall outside the maximum strength or mobility of the worker. A preferred embodiment of the invention is a clinical tool for use by physicians or other similar professionals for determining whether a particular person can perform a particular job in general, and for determining whether a person injured at work can come back to work at the worker's original job or if not whether there is a different job at the workplace that the worker can perform. In this sense, the invention can be used as a "back-to-work" tool.

### **3. Specification Amendments.**

Several minor changes have been made to the Specification to increase the readability of the Specification. No changes or additions of any substantive level have been made and no new matter has been added.

The application number of the provisional patent application on which this patent application is based has been added.

The acronym "ADA" has been defined the first time it appears, and has been replaced consistently in a couple of places in the Specification.

A Brief Description of the Drawings section has been added to give a brief description of the new figure requested by the examiner. As discussed below, this new figure is taken from Appendix C of the original patent application.

The relevant sections of the Specification describing FIG. 1 have been amended to add reference numerals and to clarify reference to FIG. 1.

### **4. Claims Amendments.**

Applicant has amended the claims to clarify the invention, to place the claims in a style preferred by the examiner, and to place the claims in better condition for allowance. All of the non-claim-ending periods have been removed from the claims and replaced with parenthesis. Several of the claims ended in semi-colons and these have been replaced with periods.

Contrary to the assertion made by the examiner in Paragraph 15 of the Office Action, there can be maximum strengths and other parameters required by a task, and this is what Claims 8 and 18 were meant to claim - the maximum strengths required to carry out a task. For example, if a particular piece weighs up to but no more than 2 pounds, and the piece must be moved from a pallet to a conveyor belt

and the pallet is always placed within 3 feet of the conveyor belt, the job would comprise two tasks having maximum parameters. First, the worker must be able to lift up to 2 pounds - the maximum weight of the piece. Second, the worker must be able to move the piece up to 3 feet - the maximum distance the pallet is placed from the conveyor. Therefore, Claims 8 and 19 are correct. However, Claims 8 and 19 have been amended slightly for clarification.

Many of the claims have been amended to clarify that the physical aspects of each task comprising each job are listed. Although the physical aspects of a particular job can be distilled from the physical aspects of each task comprising each job, the preferred embodiment involves the breaking down of the job into discrete tasks, and the comparison of the worker to the physical requirements of each task. This function is discussed throughout the Specification as originally filed and in original Claim 12, and no new matter has been added.

New Claim 21 has been added to claim the step of providing a visual presentation of the job analysis database. Although the three-part screen claimed is a preferred embodiment, as long as the tasks of each job, a pictorial representation of the tasks, and the physical requirements of the tasks are shown, the number of screen parts can be varied.

It is Applicant's assertion that the subject matter of the original claims is patentable over the art cited by the examiner, and the amendments to the claims have been made only for clarification and not to distinguish the claims from the cited art or for any other issue of patentability.

##### **5. Abstract Amendments.**

The Abstract has been amended to remove the "new and improved" language as requested by the examiner, and to include a more descriptive explanation of the invention. The additional language is taken from Claim 1 as originally filed, and no new matter has been added.

##### **6. Drawing Amendments.**

As requested by the examiner in Paragraph 8 of the Office Action, Applicant has added a drawing to the patent application to facilitate the understanding of the invention. Applicant has taken a drawing from Appendix C showing the physical demands screens as a representation of the database used to carry out the

invention. As FIG. 1 was present in the patent application as originally filed, no new matter has been added by adding this FIG. 1.

## **7. Claims Rejections - All of the Claims are Not Obvious over the Art cited by the Examiner.**

The examiner has alleged that several of the claims are obvious under 35 USC 103 over US Patent No. 6070143 to Barney (Barney '143), an article written by Mital (the Mital Article), an article written by Keyserling (the Keyserling Article), US Patent No. 5416694 to Parrish (Parrish '694) and/or US Patent No. 5050213 to Shear (Shear '213). Applicant respectfully disagrees for the reasons stated below and requests that these rejections be withdrawn.

For a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the *prior art*, (2) the *level of skill* in the art, and (3) the *differences* between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as his basis for further experimentation and to create his invention. *Id.*

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. See *Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and *as intended by reference authors*. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard).

The Federal Circuit has defined and determined the bounds of the prior art to be identical for both nonobviousness and anticipation purposes. See *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). Prior art for these purposes is pertinent art recognized by persons of ordinary skill to be in the *field of the invention*. See *In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990), *In re Horne*, 203 USPQ 969, 971 (CCPA 1979). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that

field to develop the invention given the nature of the problem. See *In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. See *In re Phipps*, 69 USPQ 88 (CCPA 1946). Nonanalogous prior art cannot properly be considered prior art under 35 USC 103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981).

The Federal Circuit has made it clear that the nonobviousness standard is applied wrongly if a court or an examiner: (1) improperly focuses on “a combination of old elements” rather than the invention as a whole; (2) ignores objective evidence of nonobviousness; (3) pays lip service to the presumption of validity; and (4) fails to make sufficient *Graham* findings. *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986). Applying the nonobviousness test counter to these principles counters the principle that a patent application is presumed nonobvious. *Id.*

Thus, to sustain a rejection under 35 USC 103, the Examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The references cited by the examiner cannot be so combined and do not establish a *prima facie* case of obviousness.

**A. A combination of Barney ‘143 and the Mital Article does not result in or make obvious the present invention.**

As acknowledged by the examiner, Barney ‘143 does not teach a method wherein the demands analysis includes the physical requirements of each discrete job. The physical requirements of the job are so unnecessary to the Barney ‘143 invention and so necessary to the present invention, that it is inappropriate to alter the Barney ‘143 invention in such drastic a fashion by combining it with the Mital Article. This is especially true in that the Mital Article discloses the creation of jobs based on generalized historical data. On the contrary, the present invention uses physical requirements from already existing jobs to create the database (it does not make up parameters for the physical requirements) and is used to see if a person has the ability to perform a specific job, and not whether a specific job can be created or tailored to be able to be performed by a representative percentage of the general population.

Barney ‘143 simply allows the user to create a survey of jobs based on non-

physical skill sets and tools necessary. Using this survey method, the user can match a person with a job based solely on knowledge and tools. Unlike the present invention, Barney '143 does not consider or contemplate the breakdown of a job into physical tasks, and allow the user to consider the physical requirements necessary for each job when trying to determine whether a worker can be placed in the job.

Similarly, the Mital Article merely discusses a method for designing a job based on historical data. In other words, the Mital Article is a guide for people designing jobs and for allowing people to design jobs for a specific segment of people, or so that a pre-determined percentage of people could carry out the potential job. This is contradictory to the present invention, which utilizes the data from already created jobs to determine whether a particular person can actually carry out the in-existence job. Thus the Mital Article teaches away from the present invention.

Although Barney '143 and the Mital Article may both relate very generally to the "ergonomics" art, they are not so related that they can be combined and applied in combination to the present patent application. Specifically, combining the Barney '143 job database for non-physical skill sets with the Mital Article guide to creating physical jobs is counterintuitive at best. Barney '143 allows the searching of an existing database to find a job for a person. The Mital Article allows the creation of new jobs based on historical data. One of skill in the art would not look to Barney '143 when trying to create a job, especially a physical job. One of skill in the art would not look to the Mital Article when trying to match a person with a particular skill set with a profession. Thus, a combination of Barney '143 and the Mital Article is inappropriate relative to the present invention.

In contradistinction, the present invention starts with the premise that the particular jobs are already created and already have certain tasks associated with them. From there, the invention can be used as a tool for determining whether a worker can perform a specific job, or whether the physical limitations that may be necessary in performing the job, such as the maximum strength or motion parameters associated with the job, fall outside the maximum strength or mobility of the worker. In this regard, the present invention is inclusionary - it is used to fit workers into already defined jobs - rather than exclusionary like the prior art.

Therefore, because the scope of the prior art does not encompass the present invention and the differences between the prior art and Applicant's invention are significant, there is no case for obviousness. See *Litton Systems, Inc. v. Honeywell*,

*Inc.*, 117 SCt 1270 (1970). Further, there is not even the merest suggestion in either Barney '143 or the Mital Article to create a combination similar to the present invention and, therefore, there is no suggestion to further experiment with those disclosed principles that could possibly render the present invention obvious based on the principles disclosed in either of or a combination of Barney '143 and/or the Mital Article. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991).

The fact that the elements in the present invention are contained in part in Barney '143 or the Mital Article does not determine the nonobviousness of the claimed invention as a whole. See *Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The examiner has given the prior art an overly broad reading by making this combination in contradistinction to the specific purposes for the ideas disclosed in Barney '143 and the Mital Article. This is inappropriate because the separate pieces of prior art should be read in the context of the patent specifications and as intended by reference authors. See *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard). The examiner has improperly focused on "a combination of old elements" rather than the invention as a whole. See *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986).

Thus, the examiner has not established a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The references cited by the examiner cannot be so combined and do not establish a *prima facie* case of obviousness. Therefore, Applicant requests that the rejections based on Barney '143 and the Mital Article be withdrawn.

#### **B. The remaining rejections are on dependent claims.**

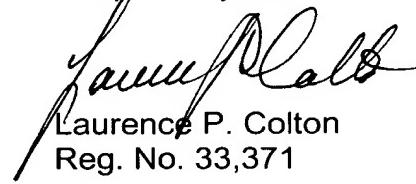
The remaining 35 USC 103 rejections using the Keyserling Article, Parrish '694, and Shear '213 are on dependent claims. As Applicant asserts that the independent claims from which these dependent claims ultimately depend are allowable, the rejection of the dependent claims on further art is moot.

## CONCLUSION

Applicant believes it has fully addressed the examiner's concerns and the application is in condition for allowance, and Applicant respectfully requests such action.

If the examiner has any final concerns that can be addressed over the telephone, the examiner is invited to contact the below-signed attorney of record.

Respectfully submitted,



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